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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/823,062 | 03/30/2001 | James Zu-Chia Teng | 1959P/STL92000011US1 | 1539 |

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11/04/2003

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EXAMINER

LE, UYEN T

ART UNIT

PAPER NUMBER

2171

DATE MAILED: 11/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/823,062

Applicant(s)

TENG ET AL.

Examiner

Uyen T Le

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-10,12-18,20-30-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-10,12-18,20-30-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. Applicant's arguments regarding claims 1-24 have been fully considered but they are moot in view of the new grounds of rejection presented in this Office Action. Note that the claimed threshold is broad enough to read on the fact that once writing to a packet is complete, the method of Hashimoto formats a next packet (see column 9, lines 16-52).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1, 2, 5, 6, 9, 10, 13, 14, 17, 18, 21, 22 are rejected under 35 U.S.C. 102(a), (e) as being anticipated by Hashimoto (US 6,172,955) of record.

Regarding claim 1, Hashimoto discloses all the claimed subject matter (see the abstract, column 2, line 43- column 5, line 20). The claimed step (a) is met by the fact that the method of Hashimoto allows recording on an optical disk without waiting for a completion of a formatting operation. The claimed step (b) is met when Hashimoto shows that the formatting process is performed as a background process so that

another process is acceptable after a start of the formatting process. The claimed step (b1) is met by the fact that formatting resumes once recording of a packet is completed (see column 9, lines 16-52).

Regarding claim 2, Hashimoto discloses that the concurrent task is a background process (see the abstract).

Regarding claim 5, Hashimoto discloses all the claimed subject matter (see the abstract, column 2, line 43- column 5, line 20). The claimed step (a) is met by the fact that the method of Hashimoto allows recording on an optical disk without waiting for a completion of a formatting operation. The claimed step (b) is met when Hashimoto shows that the formatting process is performed as a background process so that another process is acceptable after a start of the formatting process. The claimed step (b1) is met by the fact that formatting is performed concurrently with other tasks (see the abstract).

Regarding claim 6, Hashimoto discloses all the claimed subject matter (see the abstract, column 2, line 43- column 5, line 20). The claimed step (a) is met by the fact that the method of Hashimoto allows recording on an optical disk without waiting for a completion of a formatting operation. The claimed step (b) is met when Hashimoto shows that the formatting process is performed as a background process so that another process is acceptable after a start of the formatting process. The claimed step (b1) is met by the fact that the method continuously formatting the at least one subsequent increment for the database as a background process (see the abstract).

Claims 9, 10, 13, 14 correspond respectively to a computer program product for the method of claims 1, 2, 5, 6, thus are rejected for the same reasons stated in claims 1, 2, 5, 6 above.

Claims 17, 18, 21, 22 correspond respectively to a system for the method of claims 1, 2, 5, 6, thus are rejected for the same reasons stated in claims 1, 2, 5, 6 above.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 4, 7, 8, 12, 15, 16, 20, 23, 24, 26, 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hashimoto (US 6,172,955) of record, further in view of Seamons et al (US 4,924,330) of record.

Regarding claim 4, although Hashimoto does not explicitly show formatting the subsequent increment when occupation of a previous increment has reached as threshold of one-half, it is well known in the art to determine when to format subsequent increments based on occupation of a previous increment as shown by Seamons (see column 5, lines 44-52). Furthermore, although Seamons does not show that the threshold is one-half, this feature merely reads on the fact that user requirements for waiting time differ. Therefore, it would have been obvious to one of ordinary skill in the

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art to include the claimed features while implementing the method of Hashimoto in order to timely format a subsequent increment of storage for future use.

Regarding claim 7, it merely differs from claim 1 by the limitation of "triggering the database system to asynchronously format at least one subsequent increment".

Although Hashimoto does not specifically show "triggering" the formatting operation, Seamons teaches the concept of triggering a subsequent formatting operation when Seamons shows that the system automatically formats additional space when no formatted space is available or when the computer has been idle for a predetermined time (see column 5, lines 17-52). Therefore, it would have been obvious to one of ordinary skill in the art to include the claimed "triggering" feature as taught by Seamons while implementing the method of Hashimoto in order to systematically spread the formatting process over time.

Regarding claim 8, Hashimoto discloses that the concurrent task is a background process (see the abstract).

Claims 12, 15, 16 correspond respectively to a computer program product for the method of claims 4, 7, 8, thus are rejected for the same reasons stated in claims 4, 7, 8 above.

Claims 20, 23, 24 correspond respectively to a system for the method of claims 4, 7, 8, thus are rejected for the same reasons stated in claims 4, 7, 8 above.

Regarding claims 26, 30, although Hashimoto and Seamons do not explicitly show a threshold of less than one hundred percent, it would have been obvious to one

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of ordinary skill in the art to include such a threshold in order to have reality available formatted space for storing information.

4. Claims 25, 27-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hashimoto (US 6,172,955) of record.

Regarding claims 25, 27-29, although Hashimoto does not explicitly show a threshold of less than one hundred percent, it would have been obvious to one of ordinary skill in the art to include such a threshold in order to have reality available formatted space for storing information.

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Uyen T Le whose telephone number is 703-305-4134. The examiner can normally be reached on M-F 7:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on 703-308-1436. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.



Uyen Le
Primary Examiner
AU 2171

1 November 2003